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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,427	10/10/2001	James S. Little	S145-USA	9080

7590 07/01/2003

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EXAMINER	
NGUYEN, VI X	
ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/975,427	Applicant(s) LITTLE ET AL.	
	Examiner Victor X Nguyen	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Schutz (U.S. 5,741,268).

As to claim 1, Schutz discloses in Figure 1, A medical tack including a shaft (not label); an attachment point (fig. 2) formed near said point end and an attachment point (fig. 1) formed near said base end; and wherein means for varying a position of one the attachment points (figs 1, 2).

As to claims 2-4, Schutz discloses in Figure 1, wherein said means for varying the position is a nut (3, col.3 lines 5-12), an elastomer, a spring (2).

As to claims 5-6 and 10, Schutz discloses in Figure 1, wherein the medical tack further including a flange (fig. 1) near the base end for seating said spring (2); and wherein the spring is a coil spring (2) formed around the shaft (not label); and further including a washer (3, col.3 lines 5-12) adjacent to the spring (2).

Claims 11, 12 and 14 are rejected under 35 U.S.C. 102 (e) as being anticipated by Greenberg et al (U.S.6,165,192).

As to claim 11, Greenberg et al discloses in Figures 1, 2 and col. 2 lines 43-49, A retinal tack (6) including a shaft (8); an attachment point (fig. 2) formed near said point end and an attachment point (fig. 1) formed near said base end; and wherein means for varying a position of one the attachment points (figs 1, 2).

As to claims 12 and 14, Greenberg et al discloses in Figures 1, 2 and col. 2 lines 43-49, wherein said means for the attachment point is a nut (5); and wherein the shaft (8) is sized such the tack (6) will pierce the retinal device, a retina and a sclera such that the attachment point abuts a back side of the sclera and tends to prevent the tack (6) from being withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C 103 (a) as being unpatentable over Schutz (U.S. 5,741,268). Although, Schutz does not disclose the spring is a dome spring. It would have been obvious matter of design choice to modify the spring is a dome spring, since such a modification would have involved a mere change in the size or shape of a component. A change in size or shape is generally recognized as being within the level of ordinary skill in the art. In re Rose,105 USPQ 237 (CCPA 1955).

Claims 8 and 9 are rejected under 35 U.S.C 103 (a) as being unpatentable over Schutz (U.S. 5,741,268) in view of Wortrich (U.S. 5,364,365).

Regarding claims 8 and 9, Schutz discloses the invention substantially as claimed. However, Schutz, does not disclose the spring is a leaf spring.

Wortrich teaches at least the spring is a leaf spring (104, fig. 12).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Schutz by adding the spring is a leaf spring as taught by Wortrich in order to make the spring is flexible and that is capable of providing a sufficient force by the leaf spring on the tissue.

Claims 13, 15-16 and 20 are rejected under 35 U.S.C 103 (a) as being unpatentable over Greenberg et al (U.S.6,165,192) in view of Schutz (U.S. 5,741,268).

Regarding claims 13, 15-16 and 20, Greenberg et al discloses the invention substantially as claimed. However, Greenberg et al does not disclose the attachment point is a spring.

Schutz teaches at least the attachment point is the spring (figs 1, 2, item 2).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Greenberg et al by adding the attachment point is the spring as taught by Schutz in order to make the spring is flexible and that is capable of providing a sufficient force by the spring on the tissue.

Claim 17 is rejected under 35 U.S.C 103 (a) as being unpatentable over Greenberg et al (U.S.6,165,192). Although, Greenberg et al does not disclose the spring is a dome spring. It would have been obvious matter of design choice to modify the spring is a dome spring, since such a modification would have involved a mere change in the size or shape of a component. A change in size or shape is generally recognized as being within the level of ordinary skill in the art. In re Rose,105 USPQ 237 (CCPA 1955).

Claims 18 and 19 are rejected under 35 U.S.C 103 (a) as being unpatentable over Greenberg et al (U.S.6,165,192) in view of Schutz (U.S. 5,741,268) and further in view of Wortrich (U.S. 5,364,365).

Regarding claims18 and 19, Greenberg in view of Schutz disclose a retinal tack for attaching a retinal device having all limitations substantially as claimed. The combination also discloses at least the attachment point is a spring. However, the combination fails to disclose at least the spring is a leaf spring. Wortrich (see fig. 12, item 104), teaches at least the spring is a leaf spring.

It would have been obvious to one having ordinary skill in the art at the same time the invention was made in view of Wortrich to modify the combination of Greenberg in view of Schutz by adding at least the spring is a leaf spring in order to make the spring is flexible and that is capable of providing a sufficient force by the spring on the tissue.

Claims 21 and 22 are rejected under 35 U.S.C 103 (a) as being unpatentable over Schutz (U.S. 5,741,268). Although, Schutz does not disclose the spring exerts less than 0.2 g/mm across the surface of a retinal device. It would have been obvious matter of design choice to modify the spring exerts less than 0.2 g/mm across the surface of a retinal device, since such a modification would have involved a mere change in the size or shape of a component. A change in size or shape is generally recognized as being within the level of ordinary skill in the art. In re Rose,105 USPQ 237 (CCPA 1955).

Response to Arguments

3. Applicant's arguments filed 4/28/2003 have been fully considered but they are not persuasive.

Regarding applicant's argument to rejection of Schutz reference, the medical tack of the Schutz reference includes in Figure 1, A medical tack includes a shaft (not label); an attachment point (fig. 2) formed near said point end and an attachment point (fig. 1) formed near said base end; and wherein means for varying a position of one the attachment points (figs 1). Since Schutz reference discloses a tack which does include a spring in figure 1, Schutz anticipates all limitation of claim 1.

Regarding applicant's argument to rejection of Greenberg et al reference, the ocular tack of the Greenberg et al reference includes in Figure 1, 2 and col. 2 lines 43-49, A retinal tack (6) including a shaft (8); an attachment point (fig. 2) formed near said point end and an attachment point (fig. 1) formed near said base end; and wherein means for varying a position of one the attachment points (figs 1, 2). The Greenberg et al device is inherently capable of performing the same function as the applicant's device for attaching a retinal device. Therefore, the claimed invention is not patentable over Greenberg et al device.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen
Examiner
Art Unit 3731

vn VN
June 29, 2003

MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700